UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,661	02/26/2004	Christopher W. Blackburn	1842.021US1	3601

70648 7590 03/30/2011

SCHWEGMAN, LUNDBERG & WOESSNER/WMS GAMING
P.O. BOX 2938
MINNEAPOLIS, MN 55402

EXAMINER	
DEODHAR, OMKAR A	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
03/30/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
request@slwip.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/788,661
Filing Date: February 26, 2004
Appellant(s): BLACKBURN ET AL.

Rodney Lacy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/10/2011 appealing from the Office action mailed 2/26/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-36 are pending and rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Gatto US Patent No.: 6,916,247.

Lagosanto US Patent No.: 7,003,663.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham **v.** John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (US 6,916,247) in view of Lagosanto (US 7,003,663).

With respect to claims 1, 13, 25: Gatto discloses a method, gaming network (abstract) & tangible medium (Col. 17. Lines 15-20) storing executable code for providing a gaming service in a gaming network (Col. 15. Lines 20-30), the method comprising: sending service information for the gaming management service from the gaming management service to a discovery agent on the gaming network, (See Col. 15 .Lines 54-56 teaching publication of web services, UDDI, and software searching for, and binding to said services) wherein the gaming management service provides configuration updates for a plurality of gaming machines communicably coupled to the gaming network, (See Fig 1 showing a number of machines coupled to a network. See Fig 13 showing a number of gaming machine components receiving service updates as described in the cited portion of Col. 15.)

wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game; (See Col. 3. Lines 52-59 describing operation of a gaming machine.)

While Gatto discloses publishing availability of service on a gaming network (Figure 19: "Broadcast Availability" & Col. 13. Lines 64-67), utilizing a discovery agent, (Col. 15. Lines 49-56.), he does not teach the claimed sequence of:

Determining by the discovery agent if the gaming management service is authentic authorized; in response to determining that the gaming management service is authentic and authorized, publishing service information to a service repository to make the gaming management service available on the network.

This is interpreted as requiring service authorization as a prerequisite to service publication. In a related invention, Lagosanto teaches validating information prior to forming a service bundle that is to be published or released. See Lagosanto Col. 6. Lines 40-51.

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify Gatto with Lagosanto's teaching of validating information prior to forming a service bundle that is to be published or released. As described above, in Col. 15, Lines 54-56, Gatto teaches publication of web services, UDDI, and software searching for, and binding to said services. Gatto is thus amenable to being modified such that discovered applications or services are validated prior to being published or released. This yields the predictable results of precluding malicious code from being installed, let alone even published on the network. Changes to the prior art utilizing known elements yielding predictable results are considered obvious.

Gatto further discloses receiving by the discovery agent a request for the location of the service from a gaming machine coupled to the network (Figures 19 & 20), where examiner notes that the steps "Broadcast Availability," "Bind to Device" and "Communication" are interpreted as teaching this limitation. Gatto additionally discloses, returning the service information for the gaming management service to the gaming machine, sending a request to register the machine with the service, and determining if the machine is authorized (Gatto teaches registering the gaming machine with the service, (Fig. 20 & Col. 14. Lines 9-32), where it is noted that the server (112) registers (or subscribes) with specialized devices (gaming machines). The gaming machine would be have to be authorized for this registration to be successful.)

and in response to determining that the machine is authorized to use the service, processing service requests between the gaming machine and the service, (Figure 19; Col. 15. Lines 45-49; Col. 15. Lines 57-60; Col. 16. Lines 7-11; Col. 18. Lines 4-6) to provide the configuration updates the gaming machine.

With respect to claims 2, 14 and 26, Gatto discloses that the game management service is a web service, (Col. 15. Lines 49-56.)

With respect to claims 3-5, 15-17 and 27-29, Gatto discloses that peripheral devices (gaming machines or video/entertainment/game engines located in the gaming machine) issue service requests (Col. 16. Lines 1-42.) Please note that a plurality of different service types is encompassed by the disclosure of Gatto. Configuration type updates include, for example, the "immediate code upgrade," (Col. 16. Line 50.) Additionally, the featuring of downloading configurations is inherent with respect to networked devices. This disclosure combined with the discussion of service requests, as presented with respect to claim 1, fully disclose the claimed limitations.

With respect to claims 6, 18, 30, Gatto discloses that service requestors discover available services and bind to the service providers accordingly, (Col. 15. Lines 57-67.) Additionally, Gatto discloses that peripheral devices (gaming machines) are service requestors, (Col. 16. Lines 5-10.) The process of discovering all available services and subsequently binding to service providers clearly involves status queries.

With respect to claims 7-8, 19-20 and 31-32, Gatto discloses that devices are configured to offer direct asynchronous notification of events to a central server over the communication network, (Col. 2. Lines 37-45 & Figure 20.) Additionally, Gatto discloses that

the server may subscribe with the specialized devices (gaming machine) for the list of events that are of interest (interpreted as events matching certain criteria), (Col. 14. Lines 8-32.) Please also note the discussion of "callback," (Col. 14. Lines 8-32.)

With respect to claims 9-11, 21-23 and 33-35, please refer to the rejection of claims 1-7, above. Please also note that the claimed limitations of a configuration query (claim 9), status query, (claim 10), and device status, (claim 11) are query types inherent to the system because, at the least, the server is able to query every networked device to determine its status.

With respect to claim 12, 24 and 36, Gatto discloses a coin acceptor (Figure 2, Item 204) that may be coupled to the network platform (Col. 9. Lines 33-43.)

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 13 & 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, 13, 20 & 27 of copending

Application No. 10/788,902. Although the conflicting claims are not identical, they are not patentably distinct from each other. Both inventions seek to patent a method of providing game service updates on a gaming network wherein service information is sent to a discovery agent, the discovery agent determines if the service is authentic and authorized and then publishes the service information. Whereas the present application processes service requests to update gaming machines, the copending application additionally requires processing service requests to provide game content. A person of ordinary skill in the art would realize that once update information is received by a networked gaming machine, the update could also reflect game content. As such, it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to provide game content updates along with gaming machine service updates.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

1. Appellant's arguments regarding the obviousness rejection begin on page 14 of its brief. Appellant argues that the base reference, Gatto, fails to disclose "sending service information for the gaming management service from the gaming management service to a discovery agent on the gaming network," per claim 1. (App. Br. 14.) Appellant contends that Gatto's disclosure in Col. 15. Lines 33-56, of publication of web services, Universal Description Discovery and Integration, ("UDDI") and software searching for and binding to said services fails to teach the claimed limitation. (App. Br. 14.) Examiner respectfully disagrees.

2. Gatto in Fig. 19, shows a server 112 providing gaming management services to a networked, specialized device. Col. 16. Lines 1-11 disclose gaming management services

including services for maintaining an electronic gaming machine's peripheral device operations. (Note that the cited portion refers to an electronic gaming machine as an "EGD.") Col. 2. Lines 40-42 disclose that a specialized device is a networked gaming machine. The networked, specialized device, or gaming machine, discussed in Col. 15. Lines 33-56 and shown in Fig. 13, includes software implementing web-services such as UDDI, enabling the device to search for and bind to services offered by other devices such as server 112. When networked server 112 transmits gaming management services to gaming machines, it is interpreted as a "gaming management service."

3. Moreover, since the networked gaming machine searches for and binds to services offered by the server 112, it is interpreted as a "discovery agent on the gaming network." In other words, the act of "searching for" is analogous to "discovery" and since this "discovery" is implemented using software, it yields a "discovery agent."

4. Appellant next reiterates the same argument, that Gatto fails to disclose a service provider sending service information to a discovery agent. (App. Br. 15.) Appellant contends that while Gatto discloses UDDI nodes, it is silent as to how information is provided to a UDDI node in order to be published. (App. Br. 15.) Examiner respectfully disagrees. As explained in the preceding paragraph, Gatto's networked gaming machine software is configured to **"search for and bind to services"** offered by the server. "Searching for" is equivalent to "discovery." When such discovery is implemented using software on a gaming terminal, the product is a "discovery agent."

5. Moving on, Appellant argues that the prior art does not disclose "determining by the discovery agent if the gaming management service is authentic and authorized." (App. Br.

15.) Examiner respectfully disagrees. At the outset, authenticity verification is at the heart of UDDI and unsurprisingly, Gatto discloses employing security techniques including encryption and authentication to ensure that services are indeed authentic. (Col. 13. Lines 22-31.) Furthermore, Gatto discloses that his gaming machine-discovery agent includes an authentication engine, ensuring authenticity of discovered services. (Figs 9-12, authentication engine 834). Also, Gatto requires that communications between UDDI nodes at his server 112 and gaming terminal are secured. (Col. 12. Lines 5-14.) Therefore, during the bidirectional communication between gaming terminal and server, shown in Fig. 19, the gaming machine's discovery agent would determine if services discovered at UDDI nodes at server 112 are indeed authentic and authorized.

6. Moreover, notwithstanding Gatto's disclosure of authenticity verification using UDDI, a secondary reference, to Lagosanto, was introduced, which also teaches authenticating information before publication and use of a service. (Lagosanto Col. 6. Lines 40-51.) Yet, Appellant argues that since Lagosanto's disclosure of information-authentication prior to publication and use is in the context of a smart card, Lagosanto cannot render obvious its claimed invention. (App. Br. 16.) Examiner respectfully disagrees.

7. We must consider what the prior art would have suggested to persons of ordinary skill in the art at the time of Appellant's invention. Lagosanto emphasizes the need to ensure service information authenticity before it is published and made readily available to networked devices. Why? Simply put, malicious or otherwise hazardous software has the potential to cripple a network. Reliance on Lagosanto exemplifies the need for authenticating information prior to publication. When combined when Gatto's discovery agent, complying with

extensive security requirements pursuant to UDDI, the result is a discovery agent that determines if a discovered service is authentic and authorized.

8. Finally, it may be as well to point out that after all, Gatto's system is employed in a casino; a venue where billions of dollars flow. Failure to authentic and authorize services discovered for use on a gaming terminal would have potentially disastrous consequences if malicious code seeps in.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Based on the foregoing, it is believed that the rejections should be sustained.

Respectfully submitted,

/Omkar Deodhar/
Examiner, Art Unit 3714

Conferees

/David L Lewis/

Supervisory Patent Examiner, Art Unit 3714

/Daniel G. DePumpo/

Primary Examiner, Art Unit 3700